

ESTTA Tracking number: **ESTTA578836**

Filing date: **12/26/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Pandora Media, Inc.
Granted to Date of previous extension	12/25/2013
Address	2101 Webster Street, Suite 1650 Oakland, CA 94612 UNITED STATES

Attorney information	Carla B. Oakley Morgan, Lewis & Bockius LLP One Market, Spear Street Tower San Francisco, CA 94105 UNITED STATES coakley@morganlewis.com,sftrademarks@morganlewis.com,lshinn@morganlewis.com Phone:415-442-1301
----------------------	--

Applicant Information

Application No	85895674	Publication date	08/27/2013
Opposition Filing Date	12/26/2013	Opposition Period Ends	12/25/2013
Applicant	Gene Simmons Company c/o Joseph Young Associates, Ltd. New York, NY 07058 GERMANY		


Goods/Services Affected by Opposition


Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: ENTERTAINMENT SERVICES IN THE NATURE OF LIVE-ACTION, COMEDY, DRAMA AND/OR ANIMATED TELEVISION PROGRAMS; PRODUCTION OF LIVE-ACTION, COMEDY, DRAMA AND/OR ANIMATED TELEVISION PROGRAMS; LIVE-ACTION, COMEDY, DRAMA AND/OR ANIMATED MOTION PICTURE THEATRICAL FILMS; PRODUCTION OF LIVE-ACTION, COMEDY, DRAMA AND/OR ANIMATED MOTION PICTURE THEATRICAL FILMS; PROVIDING INFORMATION FOR AND/OR ACTUAL ENTERTAINMENT VIA ELECTRONIC GLOBAL COMMUNICATIONS NETWORK IN THE NATURE OF LIVE-ACTION, COMEDY, DRAMA AND/OR ANIMATED TELEVISION AND PRODUCTION OF LIVE-ACTION, COMEDY, ACTION AND/OR ANIMATED MOTION PICTURE FILMS FOR DISTRIBUTION VIA A GLOBAL COMPUTERNETWORK

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4031782	Application Date	08/05/2010
Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	PANDORA		
Design Mark			
Description of Mark	The mark consists of "PANDORA" in a blue stylized font.		
Goods/Services	<p>Class 038. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Internet broadcasting services; Internet radio broadcasting services; Radio broadcasting</p> <p>Class 041. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Entertainment services, namely, providing non-downloadable playback of music via global communications networks; Entertainment services, namely, providing nondownloadable prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; Providing an Internet website portal in the field of music</p>		

U.S. Registration No.	4031781	Application Date	08/05/2010
Registration Date	09/27/2011	Foreign Priority Date	NONE
Word Mark	PANDORA		
Design Mark			
Description of Mark	The mark consists of "PANDORA" in a stylized font.		
Goods/Services	<p>Class 038. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Internet broadcasting services; Internet radio broadcasting services; Radio broadcasting</p>		

	Class 041. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Entertainment services, namely, providing non-downloadable playback of music via global communications networks; Entertainment services, namely, providing nondownloadable prerecorded music, information in the field of music, and commentary and articles about music, all on-line via a global computer network; Providing an Internet website portal in the field of music
--	--

U.S. Registration No.	3173558	Application Date	08/01/2005
Registration Date	11/21/2006	Foreign Priority Date	NONE
Word Mark	PANDORA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Broadcasting services, namely digital audio broadcasting services provided via a global communications network Class 041. First use: First Use: 2005/07/16 First Use In Commerce: 2005/07/16 Entertainment services, namely providing prerecorded music via a global communications network and providing prerecorded music according to consumer preferences via a global communications network		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	PANDORA		
Goods/Services	Computer software for streaming, broadcasting, transmitting and reproducing music and comedy; downloadable computer software for streaming, broadcasting, transmitting and reproducing music and comedy Streaming of music and comedy of others over a global computer network and other communications networks; Internet radio broadcasting services Providing music reviews, commentary and information in the field of music over a global computer network and other communications network; entertainment services, namely, providing non-downloadable comedy performances, comedy videos, related film clips, photographs, and other multimedia materials featuring comedy by means of audio and video transmission over a global computer and other communications networks; entertainment services, namely, providing information in the field of comedy over a global computer network and other communications networks; entertainment services, namely, providing online reviews of comedy performances; entertainment services, namely, profiling of comedy tastes by providing video clips of comedy routines over a global		

	computer network where users make selections of preferred clips; entertainment services, namely, making recommendations of comedy routines based on user selection of video clips of comedy routines; arranging and conducting of concerts; entertainment services, namely, live music shows and comedy shows Providing a web site featuring technology that allows users to input their selections of music, comedy and other content so that profiling can be completed and recommendations provided for other music, comedy and other content; providing temporary access to non-downloadable software for profiling musical, comedy and other content based on consumer selections, and recommending other music, comedy and other content to consumers based on such selections
--	--

Attachments	85975319#TMSN.jpeg(bytes) 85975318#TMSN.jpeg(bytes) 78683013#TMSN.jpeg(bytes) Pandora Media, Inc. v. Gene Simmons Company, Notice of Opposition.pdf(19106 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Carla B. Oakley/
Name	Carla B. Oakley
Date	12/26/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 85895674
Filed April 4, 2013
For the mark PANDORA'S BOX
Published in the OFFICIAL GAZETTE on August 27, 2013

Pandora Media, Inc.,

Opposer,

v.

Gene Simmons Company,

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

BOX TTAB — FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Pandora Media, Inc. ("Pandora"), a Delaware corporation having a business address of 2101 Webster Street, Suite 1650, Oakland, California, 94612, believes it will be damaged by the registration of the PANDORA'S BOX mark shown in Application Serial No. 85895674, and hereby opposes same.

As grounds for the opposition, Pandora alleges as follows:

1. Pandora is the leading Internet radio service, with more than 200 million registered users. The company also presents a variety of live performances, offers information

about live concerts, and earlier this year announced an artists' touring program. Pandora earned \$427 million in revenue in fiscal year 2013, and the number of consumers enjoying its products and services continues to grow.

2. Pandora launched its services in July of 2005 and since that time has been actively promoting its products and services under its distinctive PANDORA[®] mark and name. Since at least as early as July 2005, Pandora has been providing products and services to customers under its distinctive PANDORA[®] mark and name.

3. Pandora has invested heavily to promote its PANDORA[®] brand and to establish itself as a premier Internet radio destination for music and comedy, a source for information about music and performances, as well as a sponsor and promoter of live performances. Pandora launched PANDORA COMEDY and its COMEDY GENOME PROJECT[®] in May 2011, offering users a wide variety of comedy stations and the ability to create custom comedy stations.

4. In addition to its common law rights in its PANDORA[®] mark and name, Pandora owns trademark registrations, including United States Reg. No. 4031782, United States Reg. No. 4031781 and United States Reg. No. 3173558 for the PANDORA[®] mark, with rights dating back to 2005. It also owns registrations for its PANDORA[®] mark in numerous other countries around the world, including the European Community, Australia, Canada, Chile, China, Germany, Israel, Korea, Mexico, New Zealand, South Africa and Switzerland. Pandora has used and continues to use its PANDORA[®] mark in commerce in connection with the products and services identified in its existing registrations and pending applications, including applications and registrations for its stylized P logo marks, its COMEDY GENOME PROJECT mark and its MUSIC GENOME PROJECT mark.

5. Through exclusive use, promotional efforts, and industry publicity and recognition since 2005, Pandora's PANDORA[®] mark and name are identified exclusively with Pandora in the music, comedy, entertainment and broadcast fields. Over these many years of extensive and exclusive use, Pandora has developed substantial goodwill in its PANDORA[®] mark and name.

6. By Application Serial No. 85895674 (the "Application"), Gene Simmons Company ("Applicant") seeks to register PANDORA'S BOX as a mark in class 41 for:
entertainment services in the nature of live action, comedy, drama and/or animated television programs; production of live-action, comedy, drama and/or animated television programs; live-action, comedy, drama and/or animated motion picture theatrical films; production of live-action, comedy, drama and/or animated motion picture theatrical films; providing information for and/or actual entertainment via electronic global communications network in the nature of live-action, comedy, drama and/or animated television and production of live-action, comedy, drama and/or animated motion picture films for distribution via a global computer network.

7. The Application was filed on an "intent to use" basis on April 4, 2013, and was published on August 27, 2013. Pandora timely filed a request for extension of time to oppose the application. No statement of use has been filed.

8. The proposed PANDORA'S BOX mark prominently uses and incorporates entirely the PANDORA mark and name, since PANDORA is the first and most dominant term in the Applicant's proposed mark, followed by a single syllable word that is very common.

9. There is a likelihood of confusion posed by the Applicant's plans to use PANDORA'S BOX to promote the services specified in its application. In addition to the marks

being quite similar, and there is a clear overlap in the market channels and consumers. Indeed, it is reasonable to anticipate that Pandora's products and services promoted under its PANDORA[®] mark and name will be promoted to, provided to and used by the same consumers that would purchase, obtain and use the various services identified in the Application. Pandora targets and markets to its products and services to consumers who enjoy a wide range of music, comedy and related entertainment services, just as Applicant is likely to do with the services identified in its application. The likelihood that the customers of Pandora and Applicant would overlap is high.

10. Among other things, Applicant proposes to offer comedy programming and information about comedy programming via the Internet, which would directly compete with Pandora's comedy programming and information about comedy shows and performers. Consumers may very well believe, incorrectly, that Pandora sponsors or endorsed Applicant's services, or that there is some affiliation, given the dominant use of PANDORA in the PANDORA'S BOX designation and the overlap of the services, including that both companies would be providing services via the Internet. In light of these facts, there can be no doubt that Applicant's proposed use of the term PANDORA'S BOX is likely to cause marketplace confusion and dilute the strength of Pandora's mark in the field of entertainment.

11. Based on its earlier use of its PANDORA[®] mark and name, Pandora has priority over any rights Applicant may claim to the PANDORA'S BOX mark.

12. Because the PANDORA'S BOX mark is virtually identical to Pandora's distinctive PANDORA[®] mark and name, because the services identified in the Application are directly competitive with certain of Pandora's services and at least complementary or related to other PANDORA[®] products and services, the PANDORA'S BOX mark is likely to cause

confusion, or to cause mistake, or to deceive or disparage by falsely suggesting a connection with or otherwise damaging Pandora.

WHEREFORE, Pandora prays that Application Serial No. 85895674 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Pandora.

Dated: December 26, 2013

Respectfully submitted,

By: /s/ Carla B. Oakley

Carla B. Oakley
Lindsey Shinn
Attorneys for Opposer
Pandora Media, Inc.

Morgan, Lewis & Bockius LLP
One Market, Spear Tower
San Francisco, CA 94105
Telephone: (415) 442-1301
Facsimile: (415) 442-1001
coakley@morganlewis.com (email)
lshinn@morganlewis.com (email)

PROOF OF SERVICE

I am a resident of the State of California and over the age of eighteen years, and not a party to the within action; my business address is One Market, Spear Street Tower, San Francisco, CA 94105-1126.

On December 26, 2013, I served the within documents:

NOTICE OF OPPOSITION

PARTY SERVED	METHOD OF SERVICE
William H. Cox, Esq. Peter J. Vranum, Esq. Gordon, Herlands, Randolph & Cox LLP 355 Lexington Ave New York, New York 10017-6603	Via First Class Mail

- ☒ **(BY MAIL)** I placed the sealed envelope(s) for collection and mailing by following the ordinary business practices of Morgan, Lewis & Bockius LLP, San Francisco, California. I am readily familiar with the firm's practice for collecting and processing of correspondence for mailing with the United States Postal Service, said practice being that, in the ordinary course of business, correspondence with postage fully prepaid is deposited with the United States Postal Service the same day as it is placed for collection.
- ☐ **(BY OVERNIGHT DELIVERY)** I placed the sealed envelope(s) or package(s) designated by the express service carrier for collection and overnight delivery by following the ordinary business practices of Morgan, Lewis & Bockius LLP, San Francisco, California. I am readily familiar with the firm's practice for collecting and processing of correspondence for overnight delivery, said practice being that, in the ordinary course of business, correspondence for overnight delivery is deposited with delivery fees paid or provided for at the carrier's express service offices for next-day delivery the same day as the correspondence is placed for collection.
- ☐ **(BY PERSONAL SERVICE)** I caused t the document(s) listed above to be personally delivered to the person(s) at the address(es) set forth above (through **Professional Messenger**).
- ☐ **(BY FACSIMILE)** I caused the documents to be transmitted by facsimile machine at the time stated on the attached transmission report(s). The facsimile transmission(s) was reported as complete and without error.
- ☐ **(E-MAIL)** I transmitted via E-MAIL the document(s) listed above to the person(s) at the address(es) set forth below.

Executed on December 26, 2013, at San Francisco, California. I declare under penalty of perjury, under the laws of the United States of America, that the foregoing is true and correct.

Yelena Lolua